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10/608,230	06/30/2003	Yaron Sar-Shalom	0005778USU/4247	1761

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OHLANDT, GREELEY, RUGGIERO & PERLE, LLP  
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EXAMINER
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BRUCKART, BENJAMIN R

ART UNIT	PAPER NUMBER
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2446

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/608,230	<b>Applicant(s)</b> SAR-SHALOM, YARON	
	<b>Examiner</b> BENJAMIN R. BRUCKART	<b>Art Unit</b> 2446	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 10, 12-14, 16-, 18-20, 22-33, 37-38, 40-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10, 12-14, 16-, 18-20, 22-33, 37-38, 40-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Claims 1-3, 10, 12-14, 16, 18-20, 22-33, 37-38, 40-55 are presented for examination;  
claims 1, 22, 32, 46 and 51 independent.

Claims 4-9, 11, 15, 17, 21, 34-36, 39 are cancelled.

Claims 1, 23-24, 26-27, 29, 32-33, 37-38, 40-42, 47-48, 50, 52 are amended.

Claims 53-55 are new.

The examiner draws applicant's attention to the new examiner of record in the case. See new correspondence information presented below.

### **Response to Arguments**

Applicant's arguments filed in the amendment filed 2/19/10, have been fully considered but are found not persuasive. The reasons set forth below.

### **Applicant's invention as claimed:**

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-3, 10, 12-14, 16, 18-19, 22-33, 37-38, 40-44, 46-52, 54 are rejected under 35 U.S.C. 102(e) as being unpatentable by U.S. Patent Publication No. 2003/0193961 by Moore et al.**

Regarding claim 1, an apparatus (Fig. 1) comprising:

a communication device having a messaging client (Moore: page 3-4, para 47-49; Fig. 1, tag 139; page 7, para 82);

an availability detector, that detects availability of a destination device when a call is placed from said communication device by a user to said destination device (Moore: page 5, para 66-67; the caller attempts);

wherein said messaging client of said communications device, when said availability detector indicates that said destination device is unavailable (Moore: page 5, para 66-67):

obtains addressing information of said destination device (Moore: page 16, lines 179);

generates a message on said communication device (Moore: page 16, para 180-184); and

sends said message via said communication device to said destination device in accordance with said addressing information, upon receipt of a command from said user of said communication device (Moore: page 16, 17, para 184, 186, 187).

Referring to claim 2, the communication device comprises a telephony device (para 13).

Referring to claim 3, the apparatus according to claim 1, further comprising a messaging initiator, wherein said messaging initiator is operable to provide said addressing information to said messaging client (page 5, para 66-67; caller).

Referring to claim 10, the apparatus according to claim 1, wherein said messaging client is operable to provide said addressing information in a destination field of said message (para 133).

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Referring to claim 12, the apparatus according to claim 1, wherein said message comprises one of a group of message types comprising voice message, short message, enhanced message and multimedia message (Moore: page 16, 17, para 184, 186, 187).

Referring to claim 13, the apparatus according to claim 1, wherein said message has content that comprises one of a group comprising text, audio, video, still image, multimedia and voice (Moore: page 16, 17, para 184, 186, 187).

Referring to claim 14, the apparatus of claim 1, wherein said message has a content that comprises a default message content (Moore: pages 17-18, para 17-200; text msg or voice message).

Referring to claim 16, the apparatus of claim 14, wherein said default message can be specified by a user of said communication device (Moore: pages 17-18, para 17-200; user selects voice message or text message).

Referring to claim 18, the apparatus of claim 1, wherein said availability detector is operable to detect unavailability of said destination device when said destination device does not connect after a predetermined number of rings (Moore: para 222).

Referring to claim 19, the apparatus according to claim 1, wherein said availability detector is operable to detect unavailability of said destination device when a busy signal is received from said destination device (Moore: para 222).

Regarding claim 40, the method according to claim 32, further comprising opening on said communication device an input screen for user input of message content (Moore: page 9, para 100-109; inputs vary from text to speech and can be converted with the use of a screen).

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Regarding claim 54, the apparatus according to claim 1, where said messaging client of said communication device, when said availability detector indicates that said destination device is unavailable, generates said message on said communication device by opening an input screen displayed to the user for the user to input message content and sends said message content in said message via said communication device to said destination device in accordance with said addressing information, upon receipt of a command from said user of said communication device (Moore: page 17, para 187; chat or instant message screen based on received information).

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 20 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent Publication No. 2003/0193961 by Moore et al in view of U.S. Patent Publication No. 2004/0185828 by Engelhart.**

Referring to claim 20, the Moore reference teaches the apparatus according to claim 1.

The Moore reference fails to teach a voicemail box.

However, in analogous art, the Engelhart reference teaches detecting unavailability of said destination device when a connection is made to a voicemail box of said destination device (Engelhart: Fig. 6, page 4, para 26; availability is checked when connecting the destination and then relayed to the voicemail box through the home system for forwarding information) in order to connect the calling party to the destination or allow delivering a message with or without billing the prepaid user (Page 4, para 26).

It would have been obvious to one of ordinary skill in the art to modify the system of Moore to include detecting unavailability when connecting to voicemail as taught by Engelhart

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of leaving a voicemail box in order to connect the calling party to the destination or allow delivering a message with or without billing the prepaid user (Page 4, para 26).

**Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent Publication No. 2003/0193961 by Moore et al in view of U.S. Patent Publication No. 2004/0130580 by Howard et al.**

Regarding claim 53, the Moore reference teaches the apparatus according to claim 1.

The Moore reference fails to teach the communications device has memory.

However, in analogous art, the Howard reference teaches a communications device has a memory (Fig. 2), wherein said messaging client of said communication device, uses addressing information of said destination device from said memory (Howard: page 3, para 30) in order to allow a user device to store contact information of a destination in a persistent storage that is saved even after power off (Howard: page 3, para 30).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the invention of Moore with the address information stored in the device as taught by Howard in order to allow a user device to store contact information of a destination in a persistent storage that is saved even after power off (Howard: page 3, para 30).

**Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent Publication No. 2003/0193961 by Moore et al in view of U.S. Patent No. 6,988,123 by LeClair et al.**

Regarding claim 55, the Moore reference teaches the apparatus according to claim 1.

The Moore reference fails to teach displaying the unavailable message to the user.

However, in analogous art, the LeClair reference teaches a messaging client of said communication device, when said availability detector indicates that said destination device is unavailable, generates said message on said communication device and displays said message to the user (LeClair: col. 6, lines 37-50) in order to notify the sender that the data cannot be delivered (LeClair: col. 6, lines 37-50).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to create the invention of Moore to include the notification of LeClair in order to notify the sender that the data cannot be delivered (LeClair: col. 6, lines 37-50).

Claims 22-52 are rejected for similar reasons as stated above.

### **REMARKS**

Applicant has presented amendments the independent claims. The examiner maintains the rejections, see remarks below.

#### **The Applicant Argues:**

On page 11 of the remarks, applicant argues the Moore reference fails to teach ‘the communication device obtains addressing information of the destination device.’

**In response**, the examiner respectfully submits:

The examiner maintains the rejection with Moore because it teaches the invention as claimed. Moore paragraphs 185-188 illustrate the “addressing information” presented to the client for contacting the called party when the destination (called party) is unavailable. The addressing information are the options presented to the caller for further contacting such as voicemail, chat call, paging, instant messaging. Regarding claim 51's step of ‘automatically launching,’ the examiner points out that the claim reads launching but not automatically. It is treated as such for examination purposes, automatically can be construed as broad and undefined. The trigger signal is likened to Moore’s detecting the destination is unavailable and exploration of other contact possibilities to the (see para 185). The trigger signal is the outcome of step 710, see tag 712 and 713 of Fig. 7A. Para 187 shows the trigger signal informs the caller of the username of the destination. The examiner also points out applicant claims “addressing information” which is broad and vague allowing the destination and addressing information such as contact information to read openly on the claims.

On page 12, applicant argues Moore does not teach the input screen of claim 40.

The examiner maintains Moore because page 9, para 100-109. Moore shows inputs can vary but text and emoticons can when communicating with the destination. Para 104 shows users



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input keys and digits to have certain words or symbols communicated to said applicant. Moore teaches said input screen by creating and allowing a user to input visual and textual data for transmission to the destination.

With respect to the Official Notice, MPEP 2144.03, part C states:

“To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner’s action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 (“[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.”). A general allegation that the claims define a patentable invention without any reference to the examiner’s assertion of official notice would be inadequate. If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). If applicant does not traverse the examiner’s assertion of official notice or applicant’s traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner’s assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.”

Applicant has failed to seasonably challenge the Examiner's assertions of well known subject matter in the previous Office action(s) pursuant to the requirements set forth under MPEP §2144.03. A "seasonable challenge" is an explicit demand for evidence set forth by Applicant in the next response. Accordingly, the claim limitations the Examiner considered as "well known" in the first Office action are now established as admitted prior art of record for the course of the prosecution. See *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

In an effort to expedite prosecution, the examiner has produced the art even though applicant failed to perfect the challenge under official notice.

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In an effort to expedite prosecution, the examiner implores applicant to claim in significant detail the features of the invention. The instant application is broadly composed and is subject to a mature and vast amount of prior art in follow me and forward contact art.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN R. BRUCKART whose telephone number is (571)272-3982. The examiner can normally be reached on 9:00-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey C. Pwu can be reached on (571) 272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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